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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,244	06/06/2006	Fernando Incertis Carro	FR920040018US1	4148
30449 7590 03/11/2009 SCHMEISER, OLSEN & WATTS 22 CENTURY HILL DRIVE SUITE 302 LATHAM, NY 12110				
EXAMINER STU, SARAH				
ART UNIT 2431		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,244

Applicant(s)

CARRO, FERNANDO INCERTIS

Examiner

Sarah Su

Art Unit

2431

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-32 is/are rejected.
- 7) ☒ Claim(s) 21, 22, 31, 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- _____ Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- _____ Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

FINAL ACTION

1. Amendment A, received on 30 December 2008, has been entered into record. In this amendment, claims 17, 24, 27, and 28 have been amended.
2. Claims 13-32 are presented for examination.

Response to Arguments

3. Applicant's arguments with respect to the objection to the specification have been fully considered and are persuasive. The objection of 2 October 2008 has been withdrawn.
4. Applicant's arguments filed 30 December 2008 have been fully considered but they are not persuasive.

As to the objection to claims 21, 22, 31, and 32, it is argued by the applicant that these claims are proper dependent claims of independent claims 13 and 23, respectively. The examiner respectfully disagrees. Claims 21, 22, 31, and 32 do not further limit the process as described in the independent claims. Though the claims describe a system that performs the steps described in the independent claims, claims 21, 22, 31, and 32 do not further limit the method by either including a further step or limiting an existing step. Therefore, claims 21, 22, 31, and 32 do not further limit claims 13 and 23 and are not proper dependent claims.

As to claim 13, it is argued by the applicant that Murakawa does not disclose that the private key is received from the certification authority. The examiner respectfully disagrees. Murakawa discloses that a root certificate is received from the device (S108,

Figure 10) and that a root certificate includes a public key and a private key signed with the public key (0009, lines 4-6).

Also as to claim 13, it is argued by the applicant that Murakawa does not disclose that generation of the digital signature is based on the file and the received private key. The examiner respectfully disagrees. Murakawa discloses that the data (i.e. file) and hash value are encrypted with the private key in order to create an electronic signature (0005, lines 13-15).

Further as to claim 13, it is argued by the applicant that Bhaskaran does not disclose that the dynamic data being encoded is a certificate address. The examiner respectfully disagrees. Bhaskaran discloses that dynamic data may be contact phone numbers, settings, parameters, order receipts as well as other information such as software configuration information which is helpful to the end user or others (0014, lines 6-9). It is noted that this list is non-limiting and it would have been obvious to one of ordinary skill in the art at the time of the invention to use a location (i.e. information helpful to end user) as the dynamic data.

As to claim 19, it is argued by the applicant that Murakawa does not disclose that the certificate address is an address of a server of the device. The examiner respectfully disagrees. Murakawa discloses that the root certificate has the information of the issuer (i.e. address) (0041, lines 4-9) and the root certificate may be created by the device (0029, lines 6-7).

As to claim 23, it is argued by the applicant that Murakawa does not disclose generating a certificate address from which a digital certificate may be accessed. The

examiner respectfully disagrees. Murakawa discloses that a certificate is acquired based on the information in the certificate (i.e. location) and that the information is inputted (i.e. generated) by a user (0041, lines 3-4, 6-8).

Also as to claim 23, it is argued by the applicant that Murakawa does not disclose that the certificate comprises a public key. The examiner respectfully disagrees. Murakawa discloses that a certificate includes the public key of the device (0031, lines 7-8).

Further as to claim 23, it is argued by the applicant that Murakawa does not disclose that the public key of the root certificate and the public key of the sending end is a same public key. The examiner respectfully disagrees. Murakawa discloses that the public key in the self-made certificate includes the same public key as the public and private key pair of the device (0033, lines 2-5).

Claim Objections

5. Claims 21-22 and 31-32 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 21 and 31 recite a computer readable medium comprising instructions to perform the method of claims 13 and 23, respectively. Claims 22 and 32 recite a system comprising a computer readable medium comprising instructions to perform the method of claims

13 and 23, respectively, and means for executing these instructions. These limitations do not further limit claims 13 and 23.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13, 15, 17-26, 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakawa (US 2005/0005097 A1) and in view of Bhaskaran et al. (US 2005/0188203 A1 and Bhaskaran hereinafter).

As to claim 13, Murakawa discloses a system and method for communications in public key infrastructure, the system and method having:

signing the file with the generated digital signature (0005, lines 22-23);

receiving, from a certification authority (CA) (i.e. device) who issued a digital certificate, a private key associated with the digital certificate and a certificate address (i.e. list of certificates) from which the digital certificate may be accessed (0031, lines 1-3, 7-10);

generating a digital signature based on the file and the received private key, said digital certificate comprising a public key associated with

the private key such that the generated digital signature can be verified through use of the public key (0005, lines 21-22, 24-28).

Murakawa does not disclose:

encoding the received certificate address to generate an encoded address;

merging the existing filename and the encoded address to generate a new filename;

renaming the file with the new filename.

Nonetheless, these features are well known in the art and would have been an obvious modification of the teachings disclosed by Murakawa, as evidenced by Bhaskaran. Bhaskaran discloses a system and method for packaging information with digitally signed software, the system and method having:

encoding the received certificate address (i.e. dynamic data) to generate an encoded address (0017, lines 10-11);

merging the existing filename and the encoded address to generate a new filename (0014, lines 13-16);

renaming the file with the new filename (0014, lines 13-16).

Given the teaching of Bhaskaran, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Murakawa with the teachings of Bhaskaran by encoding the certificate address into a filename. Bhaskaran recites motivation by disclosing that encoding information into a filename is an efficient way to add information to a software

package without destroying the authentication or digital signature (0005, lines 1-3). It is obvious that the teachings of Bhaskaran would have improved the teachings of Bhaskaran by encoding information into a filename in order to add information to the file without destroying authentication information within the file.

As to claim 23, Murakawa discloses:

decoding the extracted encoded address to generate a certificate address from which a digital certificate may be accessed, said digital certificate comprising a public key associated with the private key (0031, lines 10-14; 0042, lines 6-8), said digital signature being verifiable through use of the public key (0042, lines 19-22);

accessing the digital certificate from the generated certificate address (0042, lines 6-8);

extracting the public key from the accessed digital certificate (0005, lines 25-27);

verifying the digital signature by executing an authentication algorithm in conjunction with the extracted public key (0037, lines 1-2; 0038, lines 1-2; 0039, lines 1-4).

Murakawa does not disclose:

extracting the encoded address from the filename.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Murakawa, as evidenced by Bhaskaran.

Bhaskaran discloses:

extracting the encoded address from the filename (0015, lines 15-17).

Given the teaching of Bhaskaran, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Murakawa with the teachings of Bhaskaran by extracting an address from the filename. Please refer to the motivation recited above in respect to claim 13 as to why it is obvious to apply the teachings of Bhaskaran to the teachings of Murakawa.

As to claims 15 and 26, Murakawa does not disclose:

wherein the encoded address is denoted as A, wherein the existing filename is structured as F.E such that F and E respectively represent a first and second sequence of characters, and wherein the new filename is structured as F(A).E.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Murakawa, as evidenced by Bhaskaran.

Bhaskaran discloses:

wherein the encoded address (i.e. dynamic data) is denoted as A (i.e. y), wherein the existing filename is structured as F.E such that F and E respectively represent a first and second sequence of characters, and wherein the new filename is structured as F(A).E (0014, lines 13-16). The examiner asserts that it would have been obvious to one of ordinary skill in the

art to substitute parentheses for an underscore because they are both types of syntax.

Given the teaching of Bhaskaran, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Murakawa with the teachings of Bhaskaran by encoding an address into a filename by merging characters. Bhaskaran recites motivation by disclosing that merging a filename by combining characters allows it to be more user friendly so that a user can understand it (0017, lines 50-53). It is obvious that the teachings of Bhaskaran would have improved the teachings of Murakawa by encoding an address into a filename by merging characters in order to make the new filename user friendly.

As to claims 17 and 28, Murakawa does not disclose:

sending the renamed file from an owner of the digital certificate to a user.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Murakawa, as evidenced by Bhaskaran.

Bhaskaran discloses:

sending the renamed (i.e. wrapped) file from an owner (i.e. distributor) of the digital certificate to a user (0019, lines 10-12).

Given the teaching of Bhaskaran, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of

modifying the teachings of Murakawa with the teachings of Bhaskaran by sending a renamed file. Bhaskaran recites motivation by disclosing that wrapping a filename with another file can help add labels of distributor specific information such as inventory (0019, lines 1-5). It is obvious that the teachings of Bhaskaran would have improved the teachings of Murakawa by using a renamed file in order to add label functionality that would aid a distributor such as inventory information.

As to claims 18 and 29, Murakawa does not disclose:

**wherein the encoded address is compressed relative to the
certificate address.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Murakawa, as evidenced by Bhaskaran. Bhaskaran discloses:

**wherein the encoded address is compressed relative to the
certificate address (0017, lines 24-26).**

Given the teaching of Bhaskaran, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Murakawa with the teachings of Bhaskaran by compressing an address. Bhaskaran recites motivation by disclosing that using compressed data will prevent problems with computers that cannot handle long filenames (0017, lines 26-29). It is obvious that the teachings of Bhaskaran would have improved the teachings of

Murakawa by using compressed addresses in order to prevent problems with computers that can only handle filenames of limited size.

As to claims 19 and 25, Murakawa discloses:

wherein the certificate address is an address (i.e. path information) of a server of the certification authority such that the digital certificate is stored in the server (0029, lines 14-15; 0041, lines 7-9).

As to claim 20, Murakawa discloses:

prior to said receiving, sending a request to the certification authority to issue the digital certificate (0005, lines 15-16).

As to claims 21, 22, 31, and 32, Murakawa discloses:

wherein the instructions are adapted to perform the method of claim 13 (Figure 2).

As to claim 24, Murakawa discloses:

wherein the digital certificate indicates an owner of the digital certificate, and wherein the method further comprises checking the accessed digital certificate to determine the owner of the digital certificate (0034, lines 6-10; 0040, lines 3-7).

As to claim 30, Murakawa discloses:

wherein the digital certificate identifies the authentication algorithm (0040, lines 3-7).

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of Helpfile of Version 2.0 of MP3 Tag Clinic (XP-002334789 and Helpfile hereinafter).

As to claim 14, Murakawa in view of Bhaskaran does not disclose:

wherein said renaming is performed by a file system, wherein said encoding comprises replacing predetermined characters in the address with associated replacement characters, and wherein the predetermined characters are forbidden by the file system from being used in the new filename.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Murakawa in view of Bhaskaran, as evidenced by Helpfile.

Helpfile discloses a method of naming MP3 files, the method having:

wherein said renaming is performed by a file system, wherein said encoding comprises replacing predetermined characters in the address with associated replacement characters, and wherein the predetermined characters are forbidden by the file system from being used in the new filename (page 8, lines 4-5, 7-9).

Given the teaching of Helpfile, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Murakawa in view of Bhaskaran with the teachings of Helpfile by replacing forbidden characters with predetermined characters. Helpfile recites

motivation by disclosing that Windows does not allow some text characters to exist in a filename and attempting to use these characters prevents a file from being renamed (page 8, lines 4, 6-7). It is obvious that the teachings of Helpfile would have improved the teachings of Murakawa in view of Bhaskaran by replacing certain characters with predetermined characters in order to allow for filename changes even if an illegal character is input as part of the filename.

9. Claims 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of DiPierro (US 2003/0088783 A1).

As to claims 16 and 27, Murakawa in view of Bhaskaran does not disclose:

wherein the file comprises a document, wherein said signing the file comprises appending the generated digital signature to the file such that the generated digital signature is disposed between a beginning tag and an ending tag at the beginning of the file before the document.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Murakawa in view of Bhaskaran, as evidenced by DiPierro.

DiPierro discloses a system and method for secure computing, the system and method having:

wherein the file comprises a document, wherein said signing the file comprises appending the generated digital signature to the file such that

the generated digital signature is disposed between a beginning tag and an ending tag at the beginning of the file before the document (0039, lines 2-3).

Given the teaching of DiPierro, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Murakawa in view of Bhaskaran with the teachings of DiPierro by appending the signature in the header of a file. DiPierro recites motivation by disclosing that a signature is placed within the file structure, generally in the header (0041, lines 3-6) so that it can be easily located after decryption. It is obvious that the teachings of DiPierro would have improved the teachings of Murakawa in view of Bhaskaran by placing a signature in a header in order to allow for easier access after decryption.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Su whose telephone number is (571) 270-3835. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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